REMARKS

The specification has been amended to address the Examiner's objection.

Originally filed claims 7-13 have been renumbered as claims 6-12, respectively. Claims 1-12 have been amended and new claims 13-16 have been added by this paper.

The Examiner has objected to claim 7, now renumbered claim 6, for failing to limit the subject matter of claim 1. Claim 6 has been amended to clarify that the coating applied to the paper substrate has a viscosity below 5000 cPs. Applicants submit that restricting the viscosity of the coating applied to the paper substrate further limits the claimed coated paper.

Claims 1-5 and 9-13 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,096,157 to Imabeppu.

The Imabeppu reference is not § 102(b) prior art to the present application and therefore the Examiner's rejections pursuant to § 102(b) must necessarily fail. Assuming *arguendo* the Imabeppu reference is prior art, Applicants respectfully traverse the Examiner's rejections.

The Imabeppu reference discloses an ink jet paper having a cast-coated layer including alumina and an adhesive, such as polyvinyl alcohol. In one embodiment, the cast-coated layer may additionally include a cationic resin, such as polyethylenepolyamide. However, the Imabeppu reference does not disclose a paper coated with a slurry including alumina pigments, a wetting agent or nonionic polymer, and a cationic interfacial modifier. Therefore, the Imabeppu reference cannot, as a matter of law, anticipate the claims of the present application.

The Examiner appears to construe the "cationic resin" described at col. 5, ll. 27-44 of the Imabeppu reference as the "cationic interfacial modifier" required by the claims of the present application. Such a position finds no support in either the Imabeppu reference or the specification of the present application.

Furthermore, the Imabeppu reference does not disclose a slurry including about 35 to about 45 percent by weight alumina pigment, about 0.5 to about 5 percent by weight wetting agent or nonionic polymer and about 2 to about 15 percent by weight cationic interfacial modifier. Therefore, Applicants submit that the Imabuppu reference cannot anticipate the claims

of the present application.

Claims 1-5, 7 and 9-13 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,804,656 to Kaliski et al. The Examiner's rejections are respectfully traversed.

The Kaliski et al. reference discloses a suspension of clay, a nonionic surface active agent and a cationic surface active agent. The suspension may be combined with a cationic resin for preparing paper having a conductive coating.

The Kaliski et al. reference does not disclose a slurry including about 35 to about 45 percent by weight alumina pigment, about 0.5 to about 5 percent by weight wetting agent or nonionic polymer and about 2 to about 15 percent by weight cationic interfacial modifier.

The slurry claimed in the present application has a specific composition. The specific composition provides the slurry with improved suspension properties, thereby evenly distributing pigment particles when the slurry is coated into the paper substrate. The Kaliski et al. reference does not teach or suggest improving the distribution of pigment onto a substrate by preparing a slurry having about 35 to about 45 percent by weight alumina pigment, about 0.5 to about 5 percent by weight wetting agent or nonionic polymer and about 2 to about 15 percent by weight cationic interfacial modifier. Therefore, Applicants submit that the coated paper and method claimed in the present application is not obvious over the Kaliski et al. reference.

Claims 1-5 and 7-13 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,670,037 to Okura et al. in view of U.S. Patent No. 6,576,324 to Yoshino et al.

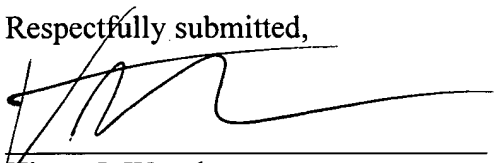
Applicants submit that the Okura et al. and Yoshino et al. references do not, alone or in combination, teach the coated paper and method claimed in the present application. The claims of the present application require, among other things, a slurry including about 35 to about 45 percent by weight alumina pigment, about 0.5 to about 5 percent by weight wetting agent or nonionic polymer and about 2 to about 15 percent by weight cationic interfacial modifier.

The coated papers and methods claimed in the present application provide a slurry having

improved suspension properties (i.e., reduced tendency for particles to settle out of suspension), thereby maintaining more pigments in suspension per unit volume and improving the distribution of pigment over the paper substrate. Therefore, Applicants submit that the claimed coated paper and method are not obvious over the Okura et al. and Yoshino et al. references.

Applicants hereby authorize the Commissioner under 37 C.F.R. § 1.136(a)(3) to treat any paper that is filed in this application, which requires an extension of time, as incorporating a request for such an extension. The Commissioner is authorized to charge any additional fees required by this paper or to credit any overpayment to Deposit Account No. 20-0809.

Respectfully submitted,



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